

REMARKS

After entry of this amendment, claims 1-35 are pending. Claim 27 has been amended to correct a typographical error. Support is found *inter alia* in the original claims. No new matter has been added.

In response to the restriction requirement set forth in the Office Action mailed March 24, 2009, Applicants hereby provisionally elect Group V (claims 1-4) corresponding to SEQ ID NO: 5 with traverse. The Applicants thank the Examiner for the offer to rejoin the amino acid sequence encoded by the provisionally elected nucleic acid sequence. Since the amino acid sequence of SEQ ID NO: 6 is encoded by the nucleic acid sequence of the provisionally elected SEQ ID NO: 5, Applicants respectfully request that SEQ ID NO: 6 be rejoined and at least SEQ ID NO: 5 and SEQ ID NO: 6 be examined together.

Applicants thank the Examiner for indicating that claim 1 links inventions of Groups I-VIII, claims 10, 18 and 20 link Groups XIII-XXX, and claims 17 and 31 link Groups LII-LVIII, and that upon allowance of the linking claims the restriction as to the linked inventions will be withdrawn.

Applicants respectfully traverse and urge reconsideration and withdrawal of the restriction requirement for the following reasons.

Because this application is a national stage filing pursuant to 35 U.S.C. § 371, unity of invention under PCT Rule 13.1 and 13.2 is the applicable standard. Unity of invention is fulfilled "when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical feature. The expression "special technical feature" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art." (PCT Rule 13.2).

The Examiner describes the technical feature linking the groups as a polypeptide having 2-methyl-6-solanylbenzoquinone methyltransferase (activity) or a nucleic acid encoding such a polypeptide or a compound with herbicidal or growth regulatory activity that is a substrate for a 2-methyl-6-solanylbenzoquinone methyltransferase. The Examiner argues that the inventions of

Group I-LX lack the same or corresponding special technical feature, because a nucleic acid allegedly 100% identical to SEQ ID NO: 3 was known, citing to Motohashi *et al.* (Genbank Accession AB054257). Applicants respectfully disagree that the instant invention does not make a contribution over the reference cited by the Examiner.

As stated in the specification and repeated in the claims, the general inventive concept of the present invention when considered as a whole relates to the use of 2-methyl-6-solanylbenzoquinone methyltransferase as a target for herbicides (page 1, lines 3-5). Motohashi *et al.* discloses an *Arabidopsis thaliana* mRNA for APG1 and the corresponding amino acid sequence. Motohashi *et al.* does not disclose 2-methyl-6-solanylbenzoquinone methyltransferase. Motohashi *et al.* does not disclose that the APG1 mRNA encodes a polypeptide with 2-methyl-6-solanylbenzoquinone methyltransferase activity, nor does it disclose the use of 2-methyl-6-solanylbenzoquinone methyltransferase as a target for herbicides. Therefore the special technical feature of the present invention makes a contribution over the reference cited by the Examiner.

Furthermore, unity of invention was found during the International stage. As shown in the International Preliminary Examination Report and International Search Report, the claims were searched and examined together. As described in MPEP § 1850 subsection I, the unity of invention standard applicable to the International stage is equally applicable during the national stage. Furthermore in MPEP § 1850 subsection II, “the decision with respect to unity of invention rests with the International Searching Authority or the International Preliminary Searching Authority.” The International Searching Authority and the International Preliminary Searching Authority applying the correct standard for unity of invention under PCT Rules 13.1 and 13.2 found that unity exists.

Moreover, PCT Article 27 entitled “National Requirements,” provides in part “(1) No national law shall require compliance with requirements relating to form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.” Thus under PCT Article 27(1), the issue of lack of unity of invention should not be raised in the national phase of a PCT application when the issue was not raised during the PCT phase. Because there was no lack of unity rejection during the

international phase by either the International Searching Authority or the International Preliminary Searching Authority, such a restriction is unjustified in the national phase of the present application.

Additionally, the Examiner has also required restriction between product and process claims (see Office Communication dated March 24, 2009, p. 9). However, under the applicable standard, claims directed to a product and a process of making and of using said product are an acceptable combination of categories pursuant to 37 CFR § 1.475(b)(3). Accordingly, Applicants respectfully request that the Examiner reconsider the restriction requirement for this additional reason.

Alternatively, at least Groups I-VIII (claims 1-4) and Groups XXIII-XXX (claims 10-16, 18 and 20) should be examined together. Both groupings (Groups I-VIII and Groups XXIII-XXX) relate to a method for identifying herbicides or herbicidally active substances comprising utilizing a 2-methyl-6-solanylbenzoquinone methyltransferase. Thus, Groups I-VIII and Groups XXIII-XXX are linked as to form a single general inventive concept and share the same and corresponding technical feature. Furthermore, a search of Groups I-VIII drawn to a method for identifying herbicides comprising utilizing a 2-methyl-6-solanylbenzoquinone methyltransferase would be equally applicable to the claims of Groups XXIII-XXX drawn to a method for identifying herbicidally active substances comprising utilizing a polypeptide with 2-methyl-6-solanylbenzoquinone methyltransferase activity. A search of claims drawn to a method for identifying herbicides comprising utilizing a 2-methyl-6-solanylbenzoquinone methyltransferase and a search of claims drawn to a method for identifying herbicidally active substances comprising utilizing a polypeptide with 2-methyl-6-solanylbenzoquinone methyltransferase activity would be commensurate in scope. Accordingly, Applicants respectfully request that the Examiner reconsider the restriction requirement and examine at least the claims of Groups I-VIII and Groups XXIII-XXX in one application.

Additionally, with the election of SEQ ID NO: 5 and its corresponding amino acid sequence SEQ ID NO: 6, all claims reciting SEQ ID NOs: 5-6 share the same feature. The same art relevant to SEQ ID NO: 5 or a nucleic acid encoding SEQ ID NO: 6 would also be relevant to products comprising SEQ ID NO: 5 or a nucleic acid encoding SEQ ID NO: 6, and to methods of

using SEQ ID NO: 5 or a nucleic acid encoding SEQ ID NO: 6. Applicants believe that there is no undue burden on the Examiner to search all the claims which recite the elected sequences in one application, as they all relate to the same elected sequences. For the above reason, Applicants respectfully request that the restriction requirement be withdrawn at least to all claims reciting the elected sequences.

CONCLUSION

For at least the above reasons, Applicants respectfully request that the restriction requirement be reconsidered and withdrawn. Alternatively, Applicants request that at least Groups I-VIII and Groups XXIII-XXX be examined together. Applicants also request that at least all claims reciting the elected sequences be examined in one application.

Applicants reserve all rights to pursue the non-elected subject matter in one or more divisional application.

This response is filed within the one month period for response from the mailing of the Office Communication, to and including April 24, 2009. No fee is believed due. However, if a fee is due, the Director is hereby authorized to charge our Deposit Account No. 03-2775, under Order No. 12810-00260-US from which the undersigned is authorized to draw.

Respectfully submitted,

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